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09/746,698	12/21/2000	Shashank Mohan Parasnis	MICR0190	9736

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MICROSOFT CORPORATION
LAW OFFICES OF RONALD M. ANDERSON
600 108TH AVENUE N.E., SUITE 507
BELLEVUE, WA 98004

EXAMINER	
QUELER, ADAM M	
ART UNIT	**PAPER NUMBER**
2178	2

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/746,698	Applicant(s) PARASNIS ET AL.
	Examiner Adam M Queler	Art Unit 2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 December 2000*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 December 2000* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Application received 12/21/2000

2. Claims 1-26 are pending in the case. Claims 1, 12, and 21 are independent claims.

Priority

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Drawings

4. The drawings are objected to because in according the specification p. 27, line 16, in Fig. 6, reference symbol **102** should be **102'**. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The use of the trademark "JavaScript" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 9, 10, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9 and 18 contain the trademark/trade name "JavaScript". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the scripting language and, accordingly, the identification/description is indefinite.

Claims 10 and 19 recite the term "composite graphic" which is not adequately defined in the specification. Based on the specification's listing of "lobby.html" (ll. 75-79) and the description of graphic **102** as a composite graphic, a composite graphic is broadly interpreted to

be 2 sections of a web page, where one is an image, located indefinitely close enough together to be associated together. While this interpretation will be used for examining purposes only, this does not adequately point out the metes and bounds of the claims, such as what would infringe on such a composite graphic

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1- are rejected under 35 U.S.C. 102(e) as being anticipated by Lakritz (US006623529B1, filed 1/28/1999).

Regarding independent claim 1, Lakritz teaches including a plurality of references in the mark-up language referencing text that are to include content when the document is rendered (col. 31, ll. 15-23). Lakritz teaches objects associated with text referenced in the markup language (col. 29, ll. 5-42). Lakritz teaches inserting the localized objects in to the markup language when it is rendered in the specified language (col. 31, ll. 15-23).

Regarding independent claim 12, Lakritz teaches including a plurality of references in the mark-up language referencing text that are to include content when the document is rendered (col. 31, ll. 15-23). Lakritz teaches objects associated with text referenced in the markup language (col. 29, ll. 5-42). Lakritz teaches inserting the localized objects in to the markup

language when it is rendered in the specified language (col. 31, ll. 15-23). Lakritz enables a user to specify the language from a list of languages (col. 4, line 42).

Regarding independent claim 21, the system for performing the method of claim 1 is rejected under the same rationale.

Regarding dependent claims 2 and 26, Lakritz enables a user to specify the language from a list of languages (col. 4, line 42).

Regarding dependent claims 3 and 13, Lakritz teaches objects are external (col. 25, l. 67).

Regarding dependent claim 4, Lakritz teaches the objects have a plurality of available languages (col. 29, ll. 33-42) and that the correct one is selected (col. 31, ll. 15-23).

Regarding dependent claim 5 and 14, Lakritz teaches selecting a language (col. 25, ll. 22-26). Lakritz teaches extracting the localized content as a function of the specified language (col. 25, ll. 54-29). Inherently, the indicia of the language must be communicated.

Regarding dependent claim 6, 15 and 25, Lakritz teaches the objects are strings (col. 31, ll. 15-23).

Regarding dependent claims 7 and 16, Lakritz teaches reference data comprising name-value pairs, in the case of one alternate language (col. 29, ll. 33-42).

Regarding dependent claims 8 and 17, inherently text data must be parsed to process it.

Regarding dependent claims 11 and 20, the computer readable mediums for performing the methods of claims 1 and 12 are rejected under the same rationale.

Regarding dependent claim 22, Lakritz teaches the documents come from a network c14-66-67.

Regarding dependent claim 23, Lakritz teaches a plurality of different languages and localized objects corresponding to different languages corresponding to text (col. 29, ll. 33-42).

Regarding dependent claim 24, Lakritz enables a user to specify the language from a list of languages (col. 4, line 42). Lakritz teaches selecting a language (col. 25, ll. 22-26). Lakritz teaches extracting the localized content as a function of the specified language (col. 25, ll. 54-29). Inherently, the indicia of the language must be communicated.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lakritz as applied to claims 1 and 12 above, and further in view of "Basics of Server-Side JavaScript", © 1997 Netscape, hereinafter SSJ, and further in view of Applicant's Admitted Prior Art.

Regarding dependent claim 9 and 18, Lakritz teaches references as described in claim 1 above. Lakritz uses a server-side based system to replace elements. It was well-known in the art that JavaScript could be used to replace the text of elements tags, as the Applicant admits on p. 19, ll. 20-21. Lakritz does not teach using JavaScript. SSJ teaches using client-side JavaScript within the HTML document (p.2, para 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Lakritz, Applicant's Admitted Prior Art, and SSJ to use

JavaScript with in a markup language to replace the placeholders of Lakritz, in order to offload processing to the client (Table 4.1).

12. Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lakritz as applied to claims 1 and 12 above, and further in view of Bos et al., "Cascading Style Sheets, level 2, CSS2 Specification, W3C Recommendation" 12-May-1998.

Regarding dependent claims 10 and 19, Lakritz discloses method of having localized portions of web pages as described in claim 1 above. Anything not contained in the references to localized objects, would be considered a global language independent portion. Lakritz generally discloses a reference manual for its invention. That is, it generally shows components that can be used together to create a web page. It does not explicitly disclose a composite graphic, Lakritz does provide the tools for creating one and how to make part of it a localized portion. The pictures along with associated text of Bos are considered to be composite graphics (pp. 4 and 5). Page 6 of the source code shows that it is an image with text. Also the text contains style sheet formatting instructions ("`<SPAN class="dlink">`"). It would have been obvious to one of ordinary skill in the art at the time of the invention to create a composite graphic with the tools of Lakritz, as it was shown in that Bos it was a known use of HTML. It would also have been obvious to one of ordinary skill in the art at the time of the invention to then apply stylistic attributes to the graphic, using style sheets, as taught by Bos, as it was an easy way to format web pages (2.1, para. 1).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 6490547 to Atkin et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (703) 308-5213. The examiner can normally be reached on Monday-Friday.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ

SANJIV SHAH
PRIMARY EXAMINER